

### REMARKS

Claims 1-55 are pending. The Office Action rejects claims 1, 2, 5-11, 18-20, 23-29, 36-38, 41-47, 54, and 55 under 35 U.S.C. §102 over Roth (U.S. Patent No. 6,285,987) and rejects claims 3, 4, 12-17, 21, 22, 30-35, 39-40, and 48-53 under 35 U.S.C. §103 over Roth in view of Official Notice. Claims 1, 19, 37, and 55 are amended. Claims 56-58 are new. Support for the amendments can be found at least in paragraphs 12, 20-22, 30-33, and throughout the specification, drawings, and claims as originally filed. No new matter has been added.

Applicants thank the Examiner for the explanation of the Office's interpretation of Roth provided in the Office Action.

#### 35 U.S.C. §102 Rejections

The Office Action rejects claims 1, 2, 5-11, 18-20, 23-29, 36-38, 41-47, 54, and 55 under 35 U.S.C. §102 over Roth. Applicants respectfully traverse this rejection for the following reasons.

Independent claim 1 recites, in relevant part,

receiving feedback on prior activities of a user **at an advertiser Web site**; and

selecting, in response to the request, advertising content **from the advertiser** for display based upon the received feedback on prior activities of the user **at the advertiser Web site**.

Independent claims 19, 37 and 55 recite similar features. The Office Action interprets Roth's bidding process as described in column 2 as selecting advertising based indirectly on prior activities of a user. *See* Office Action, ¶ 14. Regardless of whether this interpretation is correct, Roth fails to disclose selecting advertising content from a specific advertiser based on a user's activities at that advertiser's Web site. Roth merely indicates that the characteristics of a "view-op" include demographic and history information about a user. Col. 2, lines 11-19. There is no suggestion that the prior-viewed sites in Roth are advertiser sites, and especially no suggestion that a prior-viewed site is the specific advertiser's site for which history information was collected.

In fact, such a feature would render Roth's system unnecessary or cause it to function incorrectly. Roth's system selects an ad corresponding to the highest bid submitted for each view-op without regard for the source of the bid. *See* col. 2, lines 56-60. Limiting the source of the ad to a specific advertiser would remove any need for advertisers to place bids or for the system to select from multiple bids. Roth cannot include the feature described above, since doing so would prevent his system from allowing advertisers to "obtain the highest possible revenue for displaying advertisements" using the disclosed bidding process. Col. 3, lines 1-2.

For at least these reasons, Roth fails to disclose or suggest each element of the independent claims. The respective dependent claims are allowable for at least the same reasons as the independent claims, and withdrawal of the rejections and reconsideration is respectfully requested.

### **35 U.S.C. §103 Rejections**

The Office Action rejects dependent claims 3, 4, 12-17, 21, 22, 30-35, 39-40, and 48-53 as obvious over Roth, relying on Official Notice that email, FTP data transfer, coupons, customer reminders, and thank-you notes were well-known at the time of the invention. Office Action, ¶ 12; *see also* April 6, 2007 Office Action, ¶ 8. However, the Office Action fails to support a *prima facie* case of obviousness for these combinations.

As an initial matter, all claims rejected under §103 are dependent claims that are allowable for at least the same reasons as the respective independent claims as discussed above. Therefore, the §103 rejections should be withdrawn.

Furthermore, obviousness is a question of law based on underlying factual inquiries. M.P.E.P. §2144. Applicants respectfully disagree with the conclusion that Official Notice was properly taken. However, presuming *arguendo* that Official Notice is properly taken that "email and FTP data transfer was common, as were coupons to encourage purchase as well as customer reminders and thank you notes" (Apr. 6, 2007 O.A., ¶ 8) were well-known, these are merely factual findings. A finding of obviousness must be supported by "some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." M.P.E.P. §2142 (citing *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) and *KSR*,

*KSR International Co. v. Teleflex Inc.*, 82 USPQ2d at 1396 (2007)). The present Action and the earlier Action referenced therein both fail to articulate clear reasons explaining why one of skill in the art would utilize each feature as specifically recited in the claims and, therefore, fail to properly support a conclusion that the claims are obvious. As specific examples, the Office Action fails to provide any rationale for using a re-targeted advertisement as a reminder as recited in claims 15, 33, and 51, or a message indicating appreciation as recited in claims 17, 35, and 53. Therefore, for at least this additional reason, the §103 rejections should be reconsidered and withdrawn.

### **Information Disclosure Statement**

In a phone conversation on February 13, 2008, the Examiner confirmed that the objections to the August 14, 2006 IDS in the Office Action appeared to be incorrect, and indicated that the IDS would be certified and the references listed therein fully considered. The Examiner further indicated that the 1449 (form SB08) had been fully-certified in an email sent March 3, 2008. Therefore, Applicants respectfully submit that the references have been properly submitted and considered, and the objections to the IDS are moot.


**Conclusion**

Based on the above remarks, Applicants believe the claims are in condition for allowance. The Commissioner is authorized to charge any fees or credit any overpayment to the deposit account of Kenyon & Kenyon LLP, Deposit Account No. 11-0600.

The Examiner is invited to contact the undersigned to discuss any matter concerning this application.

Respectfully submitted,

Date: March 14, 2008

  
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